

REMARKS

35 U.S.C. § 101 rejections

In the papers mailed October 4, 2010, claims 175 - 197 are rejected under 35 U.S.C. §101. The Assignee will traverse the rejection of claims 175 - 197 under §101 in three ways.

1. First, by noting that there is no statutory basis for the claim rejections as the claim rejections were authored by an individual and an organization with an apparently well documented lack of average or ordinary skill in the relevant arts. It is well established patent examination needs to be completed "*in light of the specification as it would be interpreted by one of ordinary skill in the art.*" (*In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 Fed. Cir. 2004, *underline added*);
2. Second, by noting that the claim rejections fail under both standards of the APA and are therefore moot; and
3. Third, by noting that the author of said papers has failed to establish a prima facie case of non utility. *MPEP 2164.07 states "the examiner has the initial burden of challenging an asserted utility. Only after the examiner has provided evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince one of ordinary skill in the art of the invention's asserted utility. In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (*Fed. Cir. 1995*) (*citing In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (*CCPA 1981*)). The Assignee submits that the author has not met the burden required to establish a prima facie case of non utility as he or she has failed to provide any evidence to support the assertions that are the apparent basis for the rejections. The Assignee also notes that the rejections under 35 U.S.C. § 101 are contrary to the recently issued guidance from the Acting Associate Commissioner for Patent Examination Policy as the claims are all directed to providing concrete results for a real world customer and they all pass the machine or transformation test (see Appendix).

35 U.S.C. §103 rejections

In the papers mailed October 4, 2010, claims 175 - 197 are rejected under §103(a) as being obvious given U.S. Patent 6,012,053 (hereinafter, Pant) in view of U.S. Patent 5,812,988 (hereinafter, Sandretto). The author of said papers has cited Pant and Sandretto as references. The Assignee traverses the rejections for obviousness in several ways.

1. First, by noting that the claim rejections are not in compliance with the Administrative Procedures Act and are therefore moot;
2. Second, by noting the claim rejections are non-statutory. The claim rejections are non-statutory because there is no statutory basis for giving any consideration to an obviousness rejection authored by individuals with an apparent lack of the required level of average or ordinary skill in the relevant art(s); and
3. Third, by noting that the Office Action has failed to establish a prima facie case of obviousness. The cited combination of documents fails to establish a prima facie case of obviousness for claims 175 - 197 by: citing combinations of documents that teach away from the claimed invention, citing a combination of documents that fails to teach one or more limitation for every claim, failing to explain the combination as required by *KSR v Teleflex*, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function. *MPEP 2143.03 provides that: to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974))*. Finally, the Assignee notes that claim amendments have obviated these claim rejections.

35 U.S.C. §112 first paragraph rejections

In the papers mailed October 4, 2010, claims 175 - 197 are rejected under 35 U.S.C. §112 first paragraph as lacking a written description that would enable those of average skill in the art to make and use the claimed invention. Specifically, the author of said papers has made an unsupported allegation that the invention requires subjective judgments and is by definition unique, arbitrary and subjective. The Assignee will traverse the §112 first paragraph rejection of claims 175 - 197 in three ways.

1. First, by noting that the assertions regarding the alleged lack of written description are not in compliance with the both standards of the Administrative Procedures Act and are therefore moot;
2. Second, by noting the claim rejections are non-statutory. The claim rejections are non-statutory because there is no statutory basis for: rejecting a patent application because it allegedly requires subjective judgments, and/or giving any consideration to a written description rejection authored by individuals and/or an organization with an apparent lack of the required level of average or ordinary skill in the relevant art(s); and

3. Third, by noting that the Office Action has failed to establish a prima facie case that the specification does not meet the requirements of §112 first paragraph. MPEP 2163 states that: *“A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims. Wertheim, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should: (A) Identify the claim limitation at issue; and (B) Establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of “unpredictability in the art” is not a sufficient reason to support a rejection for lack of adequate written description.”* The arguments presented by the author of said papers fail to establish the prima facie case required to sustain a §112 first paragraph rejection for a single claim in at least three ways:
- a) the first way the papers mailed October 4, 2010 fail to establish the prima facie case that the specification does not meet the requirements of §112 first paragraph is that the author of said papers has not identified any reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed. To the contrary, there is substantial evidence that the comments regarding the written description were provided by individuals and an organization that appear to lack the skill in the relevant arts that are required to examine the claimed invention;
 - b) the second way the papers mailed October 4, 2010 fail to establish the prima facie case that the specification does not meet the requirements of §112 first paragraph is that the author of said papers has only made general allegations and conclusory statements (See prior 35 U.S.C. § 101 Rejection of Claims discussion); and
 - c) the third way the papers mailed October 4, 2010 fail to establish a prima facie case that the specification does not meet the requirements of §112 first paragraph is that the author of said papers has not identified the claim limitation(s) at issue.

35 U.S.C. § 112 Second Paragraph Rejections

In the papers mailed October 4, 2010 fail claims 175 - 197 are rejected under 35 U.S.C. §112 second paragraph for a variety of reasons including: allegedly lacking a written description that would enable those of average skill in the art to make and use the claimed invention. The Assignee will traverse the §112 second paragraph rejection of claims 175 - 197 in three ways.

1. First, by noting that the assertions regarding the alleged lack of written description are not in compliance with the both standards of the Administrative Procedures Act and are therefore moot.
2. Second, by noting the rejections are non-statutory. The claim rejections are non-statutory because there is no statutory basis for giving any consideration to a written description rejection authored by individuals and/or an organization with an apparent lack of the required level of average or ordinary skill in the relevant art(s).
3. Third, by noting that the Office Action has failed to establish a prima facie case that the specification does not meet the requirements of §112 second paragraph. *MPEP 2173.02 states that: definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001).* In the case of claims 175 - 197 the author of the papers mailed October 4, 2010 has failed to establish the prima facie case that the specification does not meet the requirements of §112 second paragraph in four ways for every rejected claim. The four ways are:

1. by failing to interpret the claims in light of the specification,
2. by failing to provide any evidence that someone of average skill in the relevant arts would have difficulty interpreting the claims,
3. by failing to establish that the limitation(s) in the claims fail to describe the invention and/or
4. by failing to consider the claim as a whole.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that the Assignee notes that the claims were amended to put them in final form for allowance and issue by correcting informalities.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is requested.

Respectfully submitted,

Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President

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